

REMARKS

Applicants respectfully request reconsideration of the instant application in view of the foregoing amendments and the following remarks. Claims 122-162 are currently pending in the instant application. Claims 122, 135, 136, 142, 148, 149, 155, 161 and 162 are independent claims. Applicants submit that no new matter has been added by way of this Response.

Rejections under 35 USC § 103

The Examiner has rejected claims 122-162 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Silverman, et al. (U.S. Patent no. 5,136,501; hereinafter, "Silverman") in view of Anonymous, "Wine Auctions on the Web," Newsbytes News Network, May 25, 1995 (hereinafter, "Wine"); Anonymous, "ONSALE brings thrill of the auction to the Web," Link-Up v. 12, n. 4, pp. 34, Jul/Aug 1995 (hereinafter, "ONSALE"); Rockoff, et al., "Design of an Internet-based system for remote Dutch auctions," Internet Research v. 5, n. 4, pp. 10-16, 1995 (hereinafter, "Rockoff"); and various instances of Official Notice. Applicants respectfully traverse the Examiner's rejections and submit that the Examiner has not established a *prima facie* case of obviousness and that the pending claims are patentably distinct from the cited references, taken alone or in combination, for at least the following reasons.

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,
- (iii) the proposed modification of the applied references to arrive at the claimed subject matter, and
- (iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicants submit that the rejections in the pending Office Action do not establish each of these requirements.

Applicants submit that the rejections in the January 25, 2008 Office Action fail to establish the relevant teachings of the prior art relied upon and differences in the claim over the applied references by not addressing every claim limitation. The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," [§ 2106 II(C), emphasis added] and, "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." [§ 2143.03, emphasis added].

By way of example only, Applicants note that the pending rejection has misstated the claim element, "receive a selection of a subject of goods or services from a customer," as recited in independent claim 122, as, "receive a selection of a *subset* of goods or services from a customer." (emphasis added; see, Office Action, p. 6, ¶ 7). Applicants submit that none of the references cited against the pending claims discuss or render obvious at least, "receive a selection of a subject of goods or services from a customer," as recited in the claim. The pending rejection cites several sections of Silverman against the misstated claim element. Applicants respectfully submit that Silverman's system is directed to "[a] matching system for trading instruments . . . in which bids are automatically matched against offers for given trading instruments for automatically providing matching transactions in order to complete trades for the given trading instruments" (See, Silverman, col. 3, lines 18-22). At no time is there "a selection of a subject of goods or services from a customer," as recited in independent claim 122. Accordingly, Applicants submit that the pending rejection fails to consider "all words in [the] claim," as required, for example, by MPEP § 2143.03, and respectfully request reconsideration and withdrawal of this basis for rejection. Should the Examiner disagree and maintain the rejection, Applicants respectfully request additional

clarification and specific citation from the cited references for "receive a selection of a subject of goods or services from a customer," as recited in independent claim 122. Although of different scope than claim 122, independent claims 135, 136, 142, 148, 149, 155, 161 and 162 recite the same or similar claim elements as well, and Applicants respectfully request reconsideration and withdrawal of this basis of the Examiner's rejection for these claims as well.

Furthermore, Applicants submit that the rejection in the January 25, 2008 Office Action has not established why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made by not discussing the level of ordinary skill in the art at the time of the invention and by applying impermissible hindsight.

MPEP § 2141 (II)(C) states, "Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill." The pending rejection refers to, "one of ordinary skill in the art at the time of Applicant's invention," (See, e.g., Office Action, p. 9, ¶ 1) but has provided no indication or discussion of which art is described or the level of ordinary skill associated therewith. The rejection's reference to "the art" is overly general and, consequently, does not provide a specific indication of the level of ordinary skill pertinent to the claimed subject matter. MPEP § 2141.03 (III) states, "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." Applicants submit that impermissible hindsight has been applied in asserting obviousness of the various claim elements without providing an indication of the level of ordinary skill. As such, Applicants respectfully request that, if the Examiner maintains this rejection, the Examiner discuss the level of ordinary skill in the art at the time of the invention and clarify how the claimed subject matter would have been obvious to one possessing that level of skill.

Applicants also submit that the pending rejection has applied impermissible hindsight in formulating explanations as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. By way of example only, Applicants point to the argument at p. 9, ¶ 1 of the Office Action, where the Examiner states:

The use of the internet for shopping has greatly increased the body of customers available to merchants and vice versa, thereby creating a shopping environment that better suits the material and economic needs of both merchants and customers alike. . . [I]t would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt Silverman to function over a network accessed through a web server connected to a web page that is accessed through a web browser in order to increase the body of buyers available to sellers and vice versa, thereby creating a trading environment that better suits the material and economic needs of both sellers and buyers alike.

Though the rejection provides a description of a possible advantage of the described combination of elements, it includes no explanation as to why the alleged advantage would have been evident to one of ordinary skill at the time of the invention. Furthermore, Applicants submit that the rejection's discussion of "the use of the internet" as "greatly increasing the body of customers" is overly general and includes no indication of any temporal relationship to Applicants' invention. Accordingly, Applicants submit that the rejection has applied impermissible hindsight and respectfully request reconsideration and withdrawal of this basis of the Examiner's rejection. Should the Examiner maintain the rejection, Applicants respectfully request clarification as to how the described combination would have been evident to one of ordinary skill at the time of the invention based on verifiable evidence predating Applicants' invention.

MPEP § 2142 provides that, "If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." Applicant's contend that the Examiner has not established a *prima facie* case of obviousness based at least on the reasons given above. Nevertheless, Applicant's have amended independent claims 122, 135, 136, 142, 148, 149, 155, 161 and 162 and provided the following discussion in an effort to provide clarification

and better track current business practices. Applicants maintain that the claims in their original form are patentably distinct from the cited references and reserve the right to return to that form and argue patentability at a later time.

Amended claim 122 recites, *inter alia*, "receive a payment identifier from the customer specifying a financial account for use in providing payment for said goods or services if said conditional purchase offer is accepted..." Applicants submit that the claim element is not discussed or rendered obvious by any of the cited references, taken alone or in combination. In particular, Applicants note that there is a fundamental distinction between Silverman's internal financial/credit account verification, wherein funding trading accounts occurs independently from requests to trade financial instruments, and the claim element. Accordingly, Applicants respectfully request reconsideration and withdrawal of the Examiner's rejection. Should the Examiner disagree, Applicants respectfully request clarification as to where the cited references discuss, "receive a payment identifier from the customer specifying a financial account for use in providing payment for said goods or services if said conditional purchase offer is accepted..."

Applicants further note that, while they are of different scope than claim 122, independent claims 135, 136, 142, 148, 149, 155, 161 and 162 recite the same or similar claim elements to that discussed above for claim 122. Accordingly, Applicants respectfully request reconsideration and withdrawal of the Examiner's rejection for these claims as well.

Applicants also submit that claims 123-134, 137-141, 143-147, 150-154 and 156-160, which depend directly or indirectly from independent claims 122, 135, 136, 142, 148, 149, 155, 161 and 162, are also not discussed or rendered obvious by the cited references, taken alone or in combination. Accordingly, Applicants respectfully request reconsideration and withdrawal of the Examiner's rejection for these claims as well.

CONCLUSION

Consequently, the reference(s) cited by the office action do not result in the claim elements, there was/is no reason, rationale or motivation (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)) for such a combination of references, and the claimed inventions are not admitted to be prior art. Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 122-162 all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicant believes that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements were not discussed here or in previous amendments/responses, Applicant asserts that all such remaining and not discussed claim elements, all, also are distinguished over the prior art and reserves the opportunity to more particularly remark and distinguish such remaining claim elements at a later time should it become necessary. Further, any remarks that were made in response to an Examiner objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Examiner objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicant does not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicant respectfully requests allowance, and the reconsideration and withdrawal of the rejection(s) and/or objection(s).

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17200-010CT1. In the event that an additional extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17200-010CT1.

Respectfully Submitted,
CHADBOURNE & PARKE, L.L.P.

Date: July 24, 2008

BY: /Walter G. Hanchuk/
Walter G. Hanchuk
Registration No. 35,179

Address:
Chadbourne & Parke, L.L.P.
30 Rockefeller Plaza
New York, NY 10112
212-408-5100 Telephone
212-541-5369 Facsimile